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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,949

Applicant(s)

AFRIAT, ISABELLE

Examiner

Shaojia A. Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to Applicant's amendment and response filed on January 4, 2005 wherein claims 1-29 have been amended and claim 30 is newly submitted.

Currently, claims 1-30 are pending in this application.

Claims 1-30 are examined on the merits herein.

Applicant's amendment that limits the claims herein to "only oxyalkylene are oxyethylene groups" filed on January 4, 2005 with respect to the rejection of claims 1-22 and 25-29 made under 35 U.S.C. 102(b) as being anticipated by Nadaud et al. (US 5567426) for reasons of record stated in the Office Action dated October 4, 2004 has been considered and found persuasive to remove this particular rejection. Therefore, the said rejection is withdrawn.

The following is new rejection(s) necessitated by Applicant's amendment filed on January 4, 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-22 and 25-30 are rejected under 35 U.S.C.103(a) as being unpatentable over Nadaud et al. (US 5567426, of record).

Nadaud et al. discloses that the substantially similar water-in-oil emulsion or the substantially similar cosmetic composition comprising the substantially similar ingredients in the same amounts, as instantly claimed, is useful in the same method for treating, caring for, removing make-up from and/or cleansing the skin and/or hair comprising applying the same composition herein. See the specific and particular water-in-oil emulsion or cosmetic compositions disclosed in Example 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 at col.11-17. In particular, Nadaud et al. discloses the use of the emulsifier herein, dimethicone copolyol comprising oxyalkylene having formula at col.3 lines 17-36 when the ratio of oxyethylene groups to oxypropylene groups or C₂H₄O/C₃H₆O is 100:0 and 20:80, as product sold under the name "ABIL WE 09" (see col.3 lines 37-38). Thus, dimethicone copolyol comprising oxyethylene groups only with a ratio of 100:0 mixed with oxyethylene and oxypropylene with a ratio of 20:80. Note that and oxypropylene is a **homolog** of oxyethylene by addition of a methyl (CH₃) groups.

The particular emulsion at Example 1 comprising (see col.11-12):

the aqueous phase (as taught at col.6 lines 31-38 of US 5567426) : water = 4+
(100 – the weight of all other non-water ingredients) = 4+(100-36.26) = 67.74 g;
propylene glycol (which meets claims 25 and 27 herein) = 4 + 20 g; glycerine (also
known as glycerol which meets claim 26 herein) = 0.4 + 2 = 2.4 g; sodium chloride (or
one electrolyte which meets claims 28-29 herein) = 0.16 g; preservative dyes = 0.6 g;

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Thus, the total weight percent of the aqueous phase is 94.9% by adding up all the weight of ingredients in the aqueous phase which meets the limitation herein at least 80%.

Nadaud et al. further the weigh ratio of the oily phase = 0.5g per 100 g or 0.5% of "ABIL WE 09" (which meets claim 5 herein) + 0.8g of silicone gum + 2.7 g of volatile silicone oil (which meets claim 22 herein) = 4 g.

Thus, the weigh ratio of the oily phase to the emulsifier "ABIL WE 09" is 4:0.5 = 8 which meets the limitations herein "greater than or equal to 5 or 8".

The particular emulsion at Example 3 comprising (see col.12-13):

water = $11.1 + (100 - \text{the weight of all other non-water ingredients}) = 11.1 + (100 - 40.2) = 70.9$ g, which meets the limitations herein "at least 70% by weight water relative to the total weight of the composition".

the weigh percent of the oily phase = $0.6 + 0.2 + 1 + 3.4 + 5 = 10.2$ g per 100 g or 10.2% which meets the limitations herein "oily phase is present in an amount ranging from 10% to 18% by weight" in claims 6 and 13 herein.

Regarding the inherent property, the viscosity recited in the claims herein, it is noted that, it has been well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition, so long as the prior art discloses the same composition comprising the same ingredients in the same amounts as the instantly claimed.

Nadaud et al. does not expressly disclose the employment of only oxyethylene groups in a dimethicone copolyol as emulsifier, absent any oxypropylene groups.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ oxyethylene groups only in a dimethicone copolyol as emulsifier used in the substantially similar water-in-oil emulsion of Nadaud et al.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ oxyethylene groups only in a dimethicone copolyol as emulsifier used in the substantially similar water-in-oil emulsion of Nadaud et al., because oxyethylene groups only mixed with oxypropylene is known to be used in the dimethicone copolyol of Nadaud et al. Moreover, oxypropylene and oxyethylene are homolog to each other by addition of a methyl (CH₃) groups.

Therefore, one of ordinary skill in the art would have reasonably expected that the dimethicone copolyol comprising oxyethylene groups only would have possess same or substantially similar properties and usefulness as the prior art dimethicone copolyol because of the substantially close structural relationship. It has been settled that the addition of CH₃ groups to a known compound is not ordinarily patentable and prima facie obvious. See *In re Wood*, 199 USPQ 137. Moreover, as noted in MPEP 2144.09, homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). See also *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers prima facie obvious), and If the claimed invention and the structurally similar prior art species share any useful property, that will generally be sufficient to motivate an artisan of ordinary

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skill to make the claimed species, In fact, similar properties may normally be presumed when compounds are very close in structure. Dillon, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904.

Thus, the claimed invention is deemed to be obvious over the cited prior art.

Claims 23 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Nadaud et al. in view of Hawley, G.G., The Condensed Chemical Dictionary, 10 Ed., Van Nostran Reinhold Co. New York, NY, 1981, page 423 (of record).

The same disclosure of Nadaud et al. as discussed above.

The prior art does not expressly disclose the employment of ethanol the cosmetic emulsion or composition of Nadaud et al.

Hawley teaches that ethanol is a common ingredient in cosmetics and acts as a solvent for fats and oils.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to further employ ethanol with water in the cosmetic emulsion or composition of Nadaud et al.

One having ordinary skill in the art at the time the invention was made would have been motivated to further employ ethanol with water in the cosmetic emulsion or composition of Nadaud et al. because ethanol is old and well known to be water-like solvent, being miscible with water, and a common ingredient in cosmetics and acts as a solvent for fats and oils as taught by Hawley. Thus, replacing some of water with ethanol is considered be conventional in the cosmetic art.

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Applicant's arguments filed January 4, 2005 with respect to the rejection made under 35 U.S.C. 102 have been considered but are moot in view of the new ground(s) of rejection above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 23-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,465,510 for same reasons of record stated in the Office Action dated October 4, 2004.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition to skin comprising the same ingredients including the same emulsifier herein, dimethicone copolyol in the same amounts. Thus, these emulsion and cosmetic

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composition between in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 1-9 and 23-29 are seen to be obvious over the claims 1-13 of U.S. Patent No. 6,465,510.

Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,331,306 for same reasons of record stated in the Office Action dated October 4, 2004.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition to skin comprising the same ingredients including the same emulsifier herein, dimethicone copolyol in the same amounts, and the same method or process of use the composition as instantly claimed. Thus, these emulsion and cosmetic composition and method between in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 1-29 are seen to be obvious over the claims 1-16 of U.S. Patent No. 6,331,306.

Claims 1-9 and 23-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,562,354 for same reasons of record stated in the Office Action dated October 4, 2004.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition to skin comprising the same ingredients including the same emulsifier herein, dimethicone copolyol in the same amounts. Thus, these emulsion and cosmetic composition between in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 1-9 and 23-29 are seen to be obvious over the claims 1-34 of U.S. Patent No. 6,562,354.

Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,239,174 for same reasons of record stated in the Office Action dated October 4, 2004.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition to skin comprising the same ingredients including the same emulsifier herein, dimethicone copolyol in the same amounts, and the same method or process of use the composition as instantly claimed. Thus, these emulsion and cosmetic composition and method between in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 1-29 are seen to be obvious over the claims 1-26 of U.S. Patent No. 6,239,174.

Response to Argument

Applicant's arguments filed January 4, 2005 with respect to these obviousness-type double patenting rejections in the previous Office Action October 4, 2004 have been fully considered but are not deemed persuasive as further discussed below.

Applicant argues that the cited patents do not teach "only oxyethylene groups" and specific pH ranges as well as the presence of ascorbic acid. First, note that these rejections made are based on **obviousness**-type double patenting. Thus, "only oxyethylene groups" and specific pH ranges as well as the presence of ascorbic acid are deemed to be obvious variants in view of the patents. Second, as discussed in the 103(a) rejection set forth above, the limitation, "only oxyethylene groups", is considered obvious over "only oxyethylene groups" mixed with oxypropylene groups.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.
Primary Examiner
Art Unit 1617
April 12, 2005